

### **REMARKS**

Claims 1, 2, 4, and 8-22 are pending in the present application. Claims 3 and 7 are canceled. Claims 1, 2, 8-10, 17, and 20 are amended. Claims 21 and 22 are added. Reconsideration of the claims is respectfully requested.

#### **I. 35 U.S.C. § 102, Anticipation**

The Office Action rejects claims 1, 2, 4, 8-15, and 17-20 under 35 U.S.C. § 102 as allegedly being clearly anticipated by *Hanes et al.* (U.S. Patent No. 6,466,952 B2). This rejection is respectfully traversed.

*Hanes* teaches a method for transferring and indexing data from old media to new media. In response to a source media device being connected to a data processing system, a user is prompted to transfer files from the source media device to a destination media device. See col. 2, lines 37-64. The system also automatically generates an index of the files selected for transfer. See col. 2, line 65, to col. 3, line 20.

In contradiction, the present invention provides a method, apparatus, and computer program product for remotely storing data easily from an application. A first data item is opened in an application on a first client device and a set of parameters for a user are loaded. In response to a user selecting a remote save control in a user interface of the application, the presently claimed invention stores at least a portion of the first data item in a predetermined storage location on the first client device identified in the set of preferences. Also, in response to a synchronization condition, the mechanism automatically synchronizes contents of the predetermined location with a remote storage location.

*Hanes* does not teach or suggest loading a set of user preferences and storing at least a portion of a first data item in a predetermined storage location on the first client device based on the set of user preferences. The Office Action alleges that *Hanes* teaches this feature at col. 4, lines 30-50. The cited portion of *Hanes* states:

In the preferred embodiment, data transfer application 20 communicates with source storage device 12 to learn the status of media in the drive, thereby providing automatic detection of new media 14 in the device 12. If the particular storage device does not support the detection of new media in the drive, application 20 provides a user interface 19 which allows the user to affirmatively

Page 6 of 10

Gopalan - 10/015,857

indicate to the application 20 that new media 14 is present in the source storage device 12. Affirmative user indication may be required, for example, if the source storage device 12 comprises certain types of tape drives.

Once data transfer application 20 learns of the presence of new media in source storage device 12, it then determines 22 the contents of the source media 14. Depending on the storage technology of source storage device 12, data transfer application 20 may simply read a directory contained on the media 14 which indicates what files it contains, or it may have to actually read the media 14 itself to determine its contents. For example, if the source storage device 12 is a tape drive, data transfer application 20 automatically mounts the tape and determines its contents. It may achieve this by invoking a commercial tape backup/restoration software package to mount the tape and extract the volume and file information. Alternatively, these functions may be performed by the data transfer application 20 itself. Preferably, the names and organization of the files are displayed on the output display 15 via user interface 19.

*Hanes*, col. 4, lines 27-53. Neither the cited portion nor any other portion of *Hanes* teaches or fairly suggests loading a set of preferences for a user or storing at least a portion of a data item to a predetermined storage location based on the set of preferences.

The Office Action argues that the claims recite preferences that can be broadly interpreted as any data entered by a user and that once entered, the "preferences" are loaded. The Office Action then states that Applicant's previous arguments referred to user preferences, whereas the claims recite loading "preferences for a user." In response, independent claims 1, 17, and 20 are amended to recite "user preferences" to more clearly refer to pre-existing preferences that are associated with a specific user.

Applicant submits that *Hanes* does not teach or suggest a step of opening a first data item to display the contents of the first data item in a display area of a user interface of the application, a separate step of storing at least a portion of the data item in the predetermined storage location on the first client device, and a separate step of synchronizing the contents of the predetermined storage location with a remote storage location. Rather, *Hanes* merely presents filenames and moves data items from a source to a destination. *Hanes* does not teach an application that presents the contents of a data item in a display area of a user interface of the application. *Haynes* also does not teach separate steps of storing at least a portion of the data item in a

predetermined storage location and synchronizing the contents of the predetermined storage location with a remote storage location.

The applied reference fails to teach or suggest each and every claim limitation; therefore, *Hanes* does not anticipate claim 1. Independent claims 17 and 20 recite subject matter addressed above with respect to claim 1 and are allowable for similar reasons. Since claims 2, 4, 8-16, 18, and 19, as well as new claims 21 and 22, depend from claims 1, 17, and 20, the same distinctions between *Hanes* and the invention recited in claims 1, 17, and 20 apply for these claims. Additionally, claims 2, 4, 8-16, 18, 19, 21, and 22 recite other additional combinations of features not suggested by the reference.

More particularly, with respect to claim 8, the Office Action alleges that *Hanes* teaches that the set of preferences is one of a plurality of sets of preferences in a multi-user environment at col. 4, lines 25-31, and col. 8, lines 4-6. The cited portion of *Hanes* states:

FIG. 2 is a flowchart illustrating the operation of data transfer application 20. In the illustrative embodiment, the user inserts a disc 14 into source storage device 12. Data transfer application 20 detects the presence of new media 14 in source storage device 12. In the preferred embodiment, data transfer application 20 communicates with source storage device 12 to learn the status of media in the drive, thereby providing automatic detection of new media 14 in the device 12. If the particular storage device does not support the detection of new media in the drive, application 20 provides a user interface 19 which allows the user to affirmatively indicate to the application 20 that new media 14 is present in the source storage device 12. Affirmative user indication may be required, for example, if the source storage device 12 comprises certain types of tape drives.

*Hanes*, col. 4, lines 23-37.

In the illustrative embodiment, the user may select any number of source devices, including the floppy drive (a:) 12, the hard drive (c:) 10, the CD-RW drive (d:) 16, a network server (x:) to which computer system 2 is attached in this particular illustration (not shown), or an external tape backup drive (also not shown in FIG. 1).

*Hanes*, col. 8, lines 1-6. Neither the cited portion nor any other portion of *Hanes* teaches or fairly suggests a set of preferences or a multi-user environment. Again, the Office Action cites a seemingly arbitrary portion of the reference and concludes that the claim limitations are taught

without any explanation as to how the cited portion is relevant to the claimed invention.

Therefore, the Office Action fails to establish a *prima facie* case of anticipation.

Therefore, Applicant respectfully requests withdrawal of the rejection of claims 1, 2, 4, 8-15, and 17-20 under 35 U.S.C. § 102.

## II. 35 U.S.C. § 103, Obviousness

The Office Action rejects claim 16 under 35 U.S.C. § 103 as being unpatentable over *Hanes et al.* This rejection is respectfully traversed.

With respect to claim 16, the Office Action acknowledges that *Hanes* does not disclose using a username and a password for authentication. Without any teaching in the applied prior art, the Office Action then concludes that it would have been obvious to modify *Hanes* to use a username and password.

The Office Action alleges that *Hanes* discusses using verification steps based on user input, wherein user input is relied upon to determine access to a storage system. Applicant respectfully requests the Examiner point out where this teaching occurs, because *Hanes* does not even mention the words "verify," "verification," "authenticate," and "authentication." In fact, inspection of the *Hanes* reference reveals that *Hanes* makes no mention whatsoever of verifying access rights based on user input as alleged in the Office Action.

Clearly, the Office Action fails to present a *prima facie* case of obviousness for claim 16. The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also see *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The Office Action may not merely state that the modification would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification.

Therefore, Applicant respectfully requests withdrawal of the rejection of claim 16 under 35 U.S.C. § 103.

**III. Conclusion**

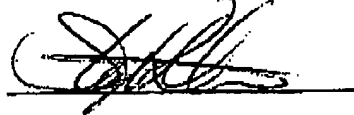
It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE:

August 22, 2005

Respectfully submitted,



Stephen R. Tkacs  
Reg. No. 46,430  
Yee & Associates, P.C.  
P.O. Box 802333  
Dallas, TX 75380  
(972) 385-8777  
Agent for Applicant